

REMARKS

This application pertains to a novel heat activable thermoplastic hot-melt adhesive which is useful for bonding electrical modules to card bodies and is activated at implanting temperatures of 150°C.

Claims 1-8 are pending.

Applicants note with appreciation the Examiner's suggestion on page 9 of the Office Action that the claims be amended to clarify the thermoplastic nature of their adhesive. The Examiner's suggestion has now been implemented. Support for "thermoplastic adhesive" can be found on page 1, line 10, of the original specification. Moreover, original claim 1 defines the adhesive system as being composed of a thermoplastic and optionally one or more resins. In addition, at page 2, line 31 and page 4, line 9 refer to thermoplastic; and page 4, line 16 discusses a softening range; clearly indicating that the polymers are thermoplastic.

No new matter is added.

The claims have also been amended to recite that the "thermoplastic" included in the adhesive is a thermoplastic polymer. Support can be found on page 4, line 16, which makes it clear that the "thermoplastic materials" included in the adhesive are polymers.

Claims 1-8 stand rejected under 35 U.S.C. 112, second paragraph, because the Examiner finds the term "heat activable" to be vague and indefinite in that he finds it unclear if the activity that the heat meant to start is the setting of the adhesive (i.e. thermosetting) or if the heating of the polymer is only meant to melt the polymer but not set it.

As suggested by the Examiner, Applicants have now amended their claims to more specifically characterize their adhesive as *thermoplastic*. With the adhesive being defined as thermoplastic, there can no longer be any doubt that the expression "heat activatable" does not refer to thermosetting, and clearly that it refers to activating the adhesive properties by heating, as is classically the case with thermoplastic adhesives. As Applicants' previously explained, a heat activatable adhesive layer is one which is not adhesive at room temperature but becomes adhesive when heated at an elevated temperature.

Accordingly, Applicants' claims can no longer be seen as vague and indefinite, and the rejection of claims 1-8 under 35 U.S.C. 112, second paragraph, should now be withdrawn.

Claims 1, 3, 4 and 7 stand rejected under 35 U.S.C. 103(a) as obvious over Feichtmeier et al (U.S. 6,350,791) and further in view of Kelch et al. (U.S. 2002/0068182).

The Feichtmeier reference is concerned with thermosettable adhesives, not thermoplastic adhesives. Even if Feichtmeier's thermosettable adhesive compositions were prepared using Kelch's GRILTEX 9 polyester, as the Examiner suggests, the result would still be a thermosettable adhesive in accordance with the teachings of Feichtmeier. Please note that Feichtmeier includes a curing system for curing his thermosettable polymer component (see abstract; col. 1, lines 35-37; col. 1, lines 66-67 and col. 7, line 32 - col. 9, line 21).

Feichtmeier's curing system (i.e., hardner...see col. 7, line 38) is specifically *excluded* by Applicants' claims in that Applicants' claims recite a ***thermoplastic*** heat-activatable adhesive sheet. If a curing system/hardner, such as is taught by Feichtmeier were present in Applicants' adhesive, such would make it thermosettable and not thermoplastic.

Accordingly, no combination of Feichtmeier and Kelch could ever lead to Applicants' ***thermoplastic*** heat-activatable adhesive sheet, and the rejection of claims 1, 3, 4 and 7 under 35 U.S.C. 103(a) as obvious over Feichtmeier et al (U.S. 6,350,791) and further in view of Kelch et al. (U.S. 2002/0068182) should now be withdrawn.

Claims 2 and 8 stand rejected under 35 U.S.C. 103(a) as obvious over Feichtmeier et al (U.S. 6,350,791) in view of Kelch et al. (U.S. 2002/0068182) and further in view of Vieilledent (U.S. 4,701,236).

The differences between the thermoplastic heat activated adhesive sheet of Applicants' claims and anything that could be found in the Feichtmeier / Kelch

combination of references are discussed above. The Examiner turns to Vieilledent for a teaching of thickness of adhesive. No thickness of adhesive could ever overcome the differences between the thermoplastic heat-activatable adhesive sheet defined by Applicants claims and anything that could be learned from the Feichtmeier / Kelch combination of references.

The rejection of claims 2 and 8 under 35 U.S.C. 103(a) as obvious over Feichtmeier et al (U.S. 6,350,791) in view of Kelch et al. (U.S. 2002/0068182) and further in view of Vieilledent (U.S. 4,701,236) should therefore now be withdrawn.

Claims 5 and 6 stand rejected under 35 U.S.C. 103(a) as obvious over Feichtmeier et al (U.S. 6,350,791) in view of Kelch et al. (U.S. 2002/0068182) and further in view of Haghiri-Tehrani (U.S. 4,897,534). The differences between the thermoplastic heat activated adhesive sheet of Applicants' claims and anything that could be found in the Feichtmeier / Kelch combination of references are discussed above. The Examiner turns to the Haghiri-Tehrani reference for a method of using an adhesive to secure a chip to a card. No method of using an adhesive to secure a chip to a card could possibly overcome the differences discussed above, and the rejection of claims 5 and 6 under 35 U.S.C. 103(a) as obvious over Feichtmeier et al (U.S. 6,350,791) in view of Kelch et al. (U.S. 2002/0068182) and further in view of Haghiri-Tehrani (U.S. 4,897,534) should therefore now be withdrawn.

In view of the present amendments and remarks it is believed that claims 1 - 8 are now in condition for allowance. Reconsideration of said claims by the Examiner is respectfully requested and the allowance thereof is courteously solicited. Should the

Examiner not deem the present amendment and remarks to place the instant claims in condition for allowance, it is respectfully requested that this Amendment Under Rule 116 be entered for the purpose of placing the prosecution record in better condition for appeal.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Applicants request that this be considered a petition therefor. Please charge the required petition fee to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fee or credit any excess to Deposit Account No. 14-1263.

Respectfully submitted,
NORRIS, McLAUGHLIN & MARCUS, P.A.

By William C. Gerstenzang/
William C. Gerstenzang
Reg. No. 27,552

WCG/tmo

875 Third Avenue, 8th Floor
New York, NY 10022
(212) 808-0700
Fax: (212) 808-0844